

Serial No.: 10/790,986
Docket No.: 09792909-5828
Amendment dated January 26, 2009
Reply to the Office Action of November 24, 2008

REMARKS

A. Introduction

Claims 1-4 and 9-20 were pending and under consideration.

In the Office Action of November 24, 2008 ("the Office Action"), claims 1-4 and 9-20 were rejected as obvious. In response, the rejections are traversed.

In view of the following remarks, reconsideration and allowance of all the pending claims are requested.

B. Rejection under 35 USC §103

Claims 1-4, 9-13, and 17-20 were rejected under 35 U.S.C. §103 as being obvious in view of U.S. Patent No. 4,272,648 to Agrawal and U.S. Patent Publication No. 2001/0025292 to Denk. The rejection is traversed for at least the following reasons.

The Examiner acknowledges that Agrawal fails to disclose or suggest a high-order part extraction element to extract a high-order part by rounding off "wherein rounding off means rounding a value to a digit of an order which is higher than the lowest order digit of the value," as recited by independent claims 1, 9, and 13. See Office Action, page 3. In attempt to remedy this deficiency, the Examiner points to Denk. However, it is impossible to combine Agrawal and Denk and there is no reasonable motivation to combine Agrawal and Denk.

The entire purpose of Agrawal is to provide increased accuracy with respect to gain control. Agrawal provides "[t]he output from the adder 62 is applied to a word length reduction circuit 63...[that] operates to provide the output signal Zn by simply discarding the M least significant bits." See Agrawal, Col. 7, Lns. 12-20 (emphasis added). Agrawal employs multiple elements and illustrates a detailed process regarding how the least significant bits are discarded and how the least significant bits are "employed via a feedback loop and are added to the next word product, which is then used to provide a next output signal." See Abstract and Col. 7 Ln. 65-Col. 8 Ln 65. It is absurd to suggest that one would be motivated to completely omit the discarding process of Agrawal. In fact, the entire purpose of Agrawal is to employ the discarded

Serial No.: 10/790,986
Docket No.: 09792909-5828
Amendment dated January 26, 2009
Reply to the Office Action of November 24, 2008

bits into a subsequent output signal for the benefit of assuring "that each output signal is a close approximation to the input signal as gain controlled by the desired gain factor" and thereby providing "extremely accurate gain control according to the number of bits in a word." *Id.*

On the other hand, the entire purpose of Denk is to provide an "Apparatus and Method For Reducing Precision of Data." See Denk, Title. Certainly, reducing precision is exactly the opposite of providing extreme accuracy. Thus, Denk teaches exactly the opposite of Agrawal and, therefore, cannot be combined with Agrawal because one of ordinary skill in the art would never have looked to Denk.

Further, one would never have looked to Denk "to minimize or eliminate error in reducing word length," as hypothesized by the Examiner in attempt to provide motivation and support the legal conclusion of obviousness. See the Office Action, page 3. The alleged motivation is derived from the "Summary of the Invention," which fails to provide any distinction between the element the Examiner argues for extraction from Denk and the Denk invention in its entirety. Thus, having read this motivation, one would never have been motivated to extract the single element.

Still further, if one reads the entire sentence of the alleged motivation instead of just the portion cited by the Examiner, one would never change Agrawal from discarding process to a rounding process. After providing a general overview of Denk as a whole, the alleged motivation reads, "[i]n this manner, errors due to rounding are minimized or eliminated." See Denk, para. 0009. Clearly, this passage teaches away from rounding and one would not have altered Agrawal to round numbers in view of Denk. Thus, the motivation to combine Agrawal and Denk is fatally flawed, which renders the Office Action deficient because it fails to articulate any reasoning to support the combination.

The Board of Patent Appeals and Interferences (BPAI) has reversed obviousness rejections if the Office Action provides no "articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." See M. Chandler and M. Spain, Appeal 2007-3120 (BPAI, May 30, 2008) (citing KSR Int'l v. Teleflex Inc., 127 S. Ct. 1727, 1741 (2007)

Serial No.: 10/790,986
Docket No.: 09792909-5828
Amendment dated January 26, 2009
Reply to the Office Action of November 24, 2008

(quoting In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Regarding the limitations recited in claims 9 and 13 that remain unexamined, the Examiner argues that the unexamined limitations appear in the preamble and that the preamble has not been given patentable weight. In response, Applicant notes that limitations in the body of the claim derive antecedent basis from the preamble and, therefore, "breathe life" into the preamble. See MPEP 2111.02, Effect of Preamble. Accordingly, all of the elements recited in the preamble of claim 9 require examination. Applicants object to the Examiner's examination of the limitations in the remarks and respectfully solicits examination of all the recited limitations.

Accordingly, for at least the reasons that (a) Denk does not remedy the deficiencies of Agrawal; (b) Denk teaches away from Agrawal and is not combinable with Agrawal without destroying the purpose of Agrawal; (c) there is no motivation to combine Agrawal and Denk; and (d) claims remain unexamined, Applicant respectfully submits that independent claims 1, 9, and 13 are allowable over Agrawal and Denk, either individually or combined, and withdrawal of this rejection and allowance of this claim are respectfully solicited. Likewise, the claims depending from independent claims 1, 9, and 13 include all of the limitations of independent claims 1, 9, and 13, and are also patentable over Agrawal and Denk.

Serial No.: 10/790,986
Docket No.: 09792909-5828
Amendment dated January 26, 2009
Reply to the Office Action of November 24, 2008

C. Conclusion

It is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, there being no other objections or rejections, this application is in condition for allowance, and a notice to this effect is earnestly solicited.

If any further fees are required in connection with the filing of this amendment, please charge the same to our Deposit Account No. 19-3140.

Respectfully submitted,
SONNENSCHEIN NATH & ROSENTHAL LLP

By /Adam C. Rehm/
Adam C. Rehm, Reg. No. 54,797
P.O. Box 061080
Wacker Drive Station, Sears Tower
Chicago, IL 60606-1080
816-460-2542 (telephone)
816-531-7545 (facsimile)

ATTORNEYS FOR APPLICANT